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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,568	05/25/2001	William P. Baker	067470.0146 (P0791)	4472
27683	7590	08/06/2004	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			BUTLER, DENNIS	
			ART UNIT	PAPER NUMBER
			2115	

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,568

Applicant(s)

BAKER ET AL.

Examiner

Dennis M. Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8,9 and 12 is/are rejected.
- 7) ☒ Claim(s) 3,4,6,7,10,11,13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. This action is in response to the application filed on May 25, 2001. Claims 1-14 are pending.
2. Applicant has submitted eight Information Disclosure Statements (IDS). There are over one hundred ninety documents that the examiner has considered in these IDSs. The examiner has considered the cited documents to the extent possible given the large number of documents cited and the limited resources provided to the examiner by the Office. The examiner is not given an unlimited amount of time to examine applicant's application. Applicant's duty of disclosure applies to information material to patentability. Applicant should not cite documents that are not material to the patentability of applicant's claimed invention. In addition, applicant should not cite information that is cumulative to information already of record or being made of record. See MPEP 2001. Applicant's claimed invention is directed to a device that can be powered through a bus or by an external power supply. Circuitry automatically determines which of the two power modes is being used to power the device and automatically reports the mode of power. Applicant's have cited numerous documents that seem to have nothing to do with the claimed invention such foam packaging, electro magnetic interference, mechanical mechanisms for inserting a memory cartridge into a drive or slot, various disk drive mechanisms and disk drive circuitry. Citing information not material to patentability such as documents that are clearly not directed to the claimed invention merely requires the examiner to expend the limited resources considering non-material information that could have been spent on other examining procedures. The examiner requests applicant to sufficiently review the cited art and

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point out any portions of the references that applicant deems material to the patentability of the claimed invention.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 5, 8, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawahara et al., U. S. Patent 6,285,092 in view of Opreescu et al., U.S. Patent 5,842,027.

Per claims 1, 2, 5, 8, 9 and 12:

A) Kawahara et al teach the following claimed items:

1. a first coupling section coupled to a bus that includes a power line with coupling sections 23 or 24 or 25 of figure 4, at column 1, lines 23-25 and 32-48 and at column 6, lines 14-36;
 2. a second coupling section coupled to a source of power (power supply 2) with coupling section 11 of figure 4 and at column 4, lines 55-63;
 3. circuitry coupled to the first and second coupling sections with figures 3 and 4;
 4. a first mode in which the circuitry draws power from the power line through the first coupling section when no power is received through the second coupling section with figure 7 and at column 10, line 52 – column 11, line 16;
 5. a second mode in which the circuitry draws power through the second coupling section when a power source is supplying power to the second coupling section with figure 7 and at column 9, line 36 – column 10, line 3;
 6. automatically determining which of the first and second modes (first and second power classes) the circuitry is operating in with figure 7, at column 9, line 36 – column 10, line 3 and at column 10, line 52 – column 11, line 16.
- B) The claims seem to differ from Kawahara et al in that Kawahara et al fails to explicitly teach automatically reporting through the first coupling section (IEEE 1394 bus) whether the circuitry is currently operating in the first or the second mode (first or second power classes) as claimed.
- C) However, Kawahara describes that Power Class Controller 7 of figures 3 and 7 supplies an output signal of the power class (mode). In addition, Kawahara

describes that Power Class Controller 7 of figures 3 and 7 sets the power class in compliance with the IEEE 1394 standard at column 7, lines 19-22. Therefore, Kawahara discloses the claimed invention except for explicitly reciting that the mode information is automatically reported through the first coupling. Oprescu teaches that it is known to automatically report (update) through the first coupling section (IEEE 1394 bus) whether the circuitry is currently operating in the first or the second mode with the current device state of figure 2, at column 6, line 65 – column 7, line 10 and at column 10, lines 15-20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically report through the first coupling section (IEEE 1394 bus) whether the circuitry is currently operating in the first or the second mode, as taught by Oprescu, in order to update the power management database to maintain accurate information. One of ordinary skill in the art would have been motivated to combine Kawahara and Oprescu because of Oprescu suggestion maintaining about each devices operational states to more precisely determine and control the efficient power utilization of the devices at column 3, lines 3-15. It would have been obvious for one of ordinary skill in the art to combine Kawahara and Oprescu because they are both directed to the problem of determining the power requirements of devices on an IEEE 1394 bus in order to efficiently manage power utilization of the devices and the bus.

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6. Claims 3-4, 6-7, 10-11 and 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis M. Butler whose telephone number is 703-305-9663. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dennis M. Butler

Dennis M. Butler

Primary Examiner

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